

Applicants' elections (filed 10/7/08) are acknowledged:

j) prostate cancer cells as the specific type of cancer cell to be contacted with the peptide in the elected method;

k) in the elected method, cancer cell proliferation is to be altered, but not augmented;

l) in the elected method, cancer cell proliferation is to be altered, although not augmented and this alteration of the cancer cell proliferation is to be achieved in the absence of a second agent;

m) in the elected method, the "polypeptide" (referred to in line 2 of claim 42) contains 10 amino acids or fewer;

There was one additional election requirement, and that is for a specific peptide that falls within the scope of claim 42 and which contains 10 or fewer amino acids. In response to this requirement, applicants have offered both of the following statements:

#1) SEQ ID NO:13 is the peptide TTDHQMARS, and

#2) applicants elect SEQ ID NO:13.

However, a significant ambiguity is created by this response. SEQ ID NO: 13 is not in fact the peptide TTDHQMARS; rather, SEQ ID NO: 13 is a genus that contains 456 different peptides. Further ambiguity stems from the fact that SEQ ID NO: 82 is the peptide TTDHQMARS. So by foregoing election of SEQ ID NO: 82, and instead choosing SEQ ID NO:13, it appears that applicants are trying to elect a genus of 456 different peptides.

The examiner has been consistent in requiring election of one and only one peptide. Applicants have thus far declined to elect one and only one peptide that falls within the scope of the claimed invention. An additional attempt is now made by the examiner to achieve this objective, as set forth below.

At the present time, applicants are held to be “non-responsive”, although at this point the remedy is very simple and clear.

The time period for response (1 month) is reset pursuant to this Office action.

. . . .

Applicants are required under 35 U.S.C. §121 to elect a specific and fully defined peptide (i.e., one and only one peptide) that falls within the scope of claim 42 for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. It is suggested that applicants abstain from using open-ended language to describe the elected peptide (e.g., “comprises”, “containing”, “consisting essentially of”, or “includes”).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/
Primary Examiner, Art Unit 1654